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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/615,814	03/14/96	JOHNSON	B C348.12-0011

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33M1/0127

EXAMINER

ASHER, K

ART UNIT	PAPER NUMBER
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3312

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DATE MAILED: 01/27/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

Responsive to communication(s) filed on 11/12/96

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-22 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-7, 10, 12, 14, 15, 16, 18, 19, & 21 is/are rejected.

Claim(s) 1-7, 10, 12, 14, 15, 16, 18, 19, & 21 is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- Notice of Reference Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10 *Claims 1-22 are rejected under the judicially created doctrine of double patenting over the claims of copending patent numbers 5533499, 5533503, 5549103, and 5476091. The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as is clearly seen by comparison of the claims. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP 804.*

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The following is a quotation of the first paragraph of 35 U.S.C. § 112:

25 *The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

30 *The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed.*

35 The original disclosure is limited to a nasal dilator only. The disclosure is not generic to dilators for all human anatomy. In other words, applicant has only disclosed the subset of a nasal dilator from the possible set of dilators for all human anatomy. It is noted that this case purports to be a CON of 08/183,916. Yet the recitation of claim 8 for a human anatomy dilator is drawn to the subject matter of patent # 5476091, which was a CIP of the same 08/183,916.

Claim 8 is rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

5 *Claims 8, 9, 11, 13, 17, 20, and 22 are rejected under 35 U.S.C. § 103 as being unpatentable over Sawyer.*

Sawyer teaches device ~~basis~~^{applicants'} broadly recited in claim 1 by the unit truss (figure 2) which comprises a resilient member and first and second end regions 5/6 which dilate the nose by the restoring force of the spring/resilient member. With regard to the recitation of a normally planar state, no difference is seen between this and the teachings of Sawyer to bend the device contrary to its natural state so as to generate a restoring force (page 1, column 2). With regard to claim 3, note the lack of adhesive between end regions 5/6. The recitation of release liners to cover the adhesive members would have been obvious to one of ordinary skill in the art given the plethora of such arrangement in almost all arts. The substitution of one known spring material for another would also have been obvious to one of ordinary skill in the art, especially given the teachings of Sawyer in page 1, lines 68+. It would have been obvious to one of ordinary skill in the art at the time the invention was made as the simple evolution of the 1919 Sawyer device.

20 *Claims 10, 12, 14-16, 18, 19, and 21 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, to include all of the limitations of the base claim and any intervening claims; IF THEY ARE OF SCOPE DIFFERENT THAN THAT GRANTED IN THE PREVIOUS CASES, AND IF AN ACCEPTABLE TERMINAL DISCLAIMER IS FILED.*

Claims 1-7 would be allowable over the prior art of record, IF THEY ARE OF SCOPE DIFFERENT THAN THAT GRANTED IN THE PREVIOUS CASES, AND IF AN ACCEPTABLE TERMINAL DISCLAIMER IS FILED.

5 *Applicants'* arguments and Rule 1.132 Affidavit filed 11/12/1996, have been fully considered but they are not deemed to be persuasive.

affidavit is insufficient to overcome the rejection of claims 8, 9, 11, 13, 17, 20, and 10 22 because there is no nexus between the subject matter claimed here and that described as providing the commercial success. Specifically, affidavit relies on the provision of the resilient band springs in combination with the planar truss. The resilient band springs are not recited in claims 8, 9, 11, 13, 17, 20, and 22. 15 arguments directed to their interpretation of In re Schneller are not persuasive because open claim terminology in both the instant application and the patents cited does extend coverage of the patents. This is the point of a double patenting rejection based upon In re Schneller. arguments directed to the new matter rejection are not persuasive because original disclosure fails to provide support for the breadth of claim 8. According to arguments they could claim a wound dilator, a mouth dilator, a 20 wrinkle dilator, etc. This is clearly erroneous. All that applicant disclosed in their original application was a nasal dilator. That was all that was described, discussed or illustrated. Every time the word "dilator" appears in the original disclosure, it is preceded by "nasal". Applicant is not entitled to coverage of anything but a nasal dilator. "inherency" arguments are completely non-persuasive because applicant have

failed to prove that their nasal dilator could function as a dilator for any human tissue. Further, excessively broad language of claim 8 would not distinguish over the wrinkle smoothing patent cited in one of the parent applications. arguments directed to "unitary" is also completely non-persuasive and is contradicted by their own 132 Affidavit where they discuss selling of 150,000,000 units. If the device of Appendix A is a "unit" so is the Sawyer device. Clearly, ^{applicants} device also requires "assembly" before being sold. arguments directed to differences between truss and the truss of Sawyer are not persuasive because applicant is relying on conclusions as to "uniform restoring force" and "the natural bent state" of Sawyer. Further, arguments are not consistent in scope with the shear breadth of their independent claim 8. arguments bridging pages 8 and 9 of the 11/12/1996 response are also not persuasive with regard to claim 8 because Sawyer teaches the structure recited in claim 8, i.e. " a dilator", " a truss of a single body" (wire 7) with spaced apart end surfaces, and "engagement means" at said end surfaces (the bent portions of Sawyer's wire 7 at 8 and 9). The difference being that the engagement means of Sawyer (pads or cups, 5/10) are attached mechanically vs. adhesively as is recognized in the rejection of these claims. ^{Ap's} final arguments directed to the advantage of adhesively attaching the truss to the user's nose being an improvement over Sawyer, allegedly evidenced by competitors, is not persuasive because again because arguments are not consistent in scope with their claim language. Claim 8 does not require that the truss be adhesively attached all

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along its underside to the wearer's nose. The Terminal Disclaimer filed 11/12/1996 is defective because 1) no documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office; 2) no statement specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief title is in the assignee seeking to take action; and 3) does not cover all of the patents the double patenting rejections are based upon.

10 ***THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).***

15 ***A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.***

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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner K. L. Asher at telephone number (703) 308-0858.

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Any inquiry of a general nature should be directed to the Group receptionist at (703) 308-0858.

5 *Status inquiries are to be handled according to MPEP section 203, and directed to the Group receptionist, not the Examiner.*

Inquiries as to Terminal Disclaimer and PCT requirements should be directed to the Group Paralegal, Mr. Andre Robinson, at (703) 308-2104.

10 *The facsimile phone number for Art Unit 3312 is (703) 308 - 3139. **PLEASE CALL THE EXAMINER PRIOR TO SENDING ANY FAX.** This will ensure that the Examiner receives the fax promptly.*

15 *January 23, 1997*



KIMBERLY L. ASHER
PRIMARY EXAMINER
GROUP 3300